

09/848,003
Art Unit 3693
9227.00

REMARKS

This Amendment is submitted in response to the Office Action mailed on October 29, 2008. Claims 44, 46, and 47 are pending. All other claims have been cancelled. Claims 48 and 49 are added. No fee is due. Claim 49 replaces prior claim 45.

COMMENT ON A SPECIFIC AMENDMENT

Background

It may be possible that ancient ATM machines operated without communication with a remote computer. Thus, if one wished to withdraw cash, one simply submitted his ATM card and PIN. The postulated ATM dispensed the cash, and billed the customer's account, without consulting the customer's account balance.

It could be argued that part of the claims read on such an ATM, and that the PIN which the customer enters into the postulated ATM corresponds to the "authorization message" which was "obtained from an authorization center of a financial institution before making the requested ATM transaction." That is, the argument asserts that the PIN was obtained from the "authorization center" at some time in the past.

It could be argued that East teaches such a postulated ATM to a person skilled in the art.

09/848,003
Art Unit 3693
9227.00

Comment on the Specific Amendment

The added language "in connection with the requested ATM transaction" in claim 44(b) indicates that the "authorization message" relates to the specific "requested ATM transaction." It is not the issuance of an ordinary PIN for later repeated use by a customer.

RESPONSE TO 112 - OBJECTIONS / REJECTIONS

Re: Duplication

The Office Action states that claim 47 is a duplicate of claim 44. However, Applicant points out the following differences between the two claims.

One difference is that claim 44(c) recites determining whether the "message" is "valid." Claim 47(c) recites determining whether **a specific item contained in a "message"** has been "modified." Those are different processes. For example, if the specific content of claim 47(c) has **NOT** been modified, the "message" can still be **invalid**. That is, by analogy, the fact that **part** of a hundred-dollar bill is authentic does not mean that the **remainder** of the bill is authentic.

Thus, claim 44 states that the (entire) message is determined to be valid. Claim 47 states that **part** of the message is determined to be valid.

Another difference is that claims 44 and 47 rely on different

09/848,003
Art Unit 3693
9227.00

conditions for occurrence of an event. The event is that a transaction is executed without additional authorization.

-- The condition in claim 44(d) is that the "message" is determined to be "valid."

-- The condition in claim 47(d) is that the event occurs **"only when" PART** of the "message" is found to be non-modified.

The differences include these:

-- In claim 44(d), the transaction can be executed under other circumstances. That is, other conditions can induce the event. (For example, a supervisor can overrule the determination of non-validity.) The condition is a "sufficient" condition.

However, in claim 47(d), the transaction occurs "only when" the stated conditions occur. The transaction cannot occur under other circumstances. The condition is a "necessary" condition.

-- Another difference lies in the condition which allows the transaction to proceed. In claim 44(d), the condition is that the "message" is "valid." In claim 47(d) the condition is that **part of** the "message" is **NOT**

09/848,003
Art Unit 3693
9227.00

modified. Those are different conditions.

Therefore, Applicant submits that claims 44 and 47 are different.

Re: Phrase "Unique Transaction Program Identifier"

This term appears in the Specification, page 10, line 11, in a sentence which states:

The controller 52 uses transaction program 98 to prepare an authorization request (step 122) that includes the user's account details, the user's PIN, the **unique transaction program identifier**, and the prepared transaction requested (withdraw twenty pounds).

Re: "Transmission Program" in Claim 45

The undersigned attorney's copy of pending claim 45 does not appear to contain the error asserted by the Office Action.

Nevertheless, claim 45 has been cancelled, and is replaced by new claim 49, in which this error is absent.

Outline of One Form of the Invention

Ordinarily, when a customer withdraws cash from an ATM, Automated Teller Machine, the ATM contacts a remote computer over a private, secure network, to perform such tasks as determining whether (1) the customer has a sufficient balance to cover the

09/848,003
Art Unit 3693
9227.00

withdrawal and (2) the customer is authorized to make the withdrawal.

However, such networks are expensive.

In one form of the invention, an ATM has no network connection. (Specification, page 3, line 5 et seq.) Then how does the ATM then make the determinations described above ?

A portable device carried by the customer contacts the remote computer and obtains authorization, as by making a cell phone call. The portable device then relays the authorization to the ATM. Appropriate encryption techniques are implemented to prevent the portable device from fabricating an authorization. (Specification, page 5, lines 1 - 15.)

RESPONSE TO 103 - REJECTIONS

Point 1

Even if References are Combined, Invention is not Attained Part 1

East shows an ordinary ATM, which he also calls an "EBM," Electronic Banking Machine. He states:

Any reference hereinafter to an EBM **must be interpreted** to mean an EBM of the above general type.

(Column 1, lines 38, 39.)

09/848,003
Art Unit 3693
9227.00

Thus, the EBM / ATM of East is of the ordinary type, and obtains authorization for transactions from a remote computer of the bank owning the ATM. Applicant's Specification, page 1, line 17 et seq., describes the networks used for this authorization.

All claims recite that such authorization **is not present**. (See claim 44(d) and 47(d), for example.)

Therefore, the claimed **absence** of "additional . . . authorization," as in claims 44(d) and 47(d) is not found in the references, even if combined.

MPEP § 2143.03 states:

To establish prima facie obviousness . . . **all the claim limitations** must be taught or suggested by the prior art.

Point 2

Even if References are Combined, Invention is not Attained Part 2

The Office Action, page 4, first paragraph, states that East shows "executing the requested ATM transaction without obtaining any additional authorization message from an authorization center . . ." The Office Action cites East's column 5, lines 16 - 31, as showing this.

Applicant will respectfully point out two errors in the Office Action, after briefly describing East.

09/848,003
Art Unit 3693
9227.00

East Reference

East shows a system in which a user of an ATM utilizes a personal, portable keypad to enter his PIN. This prevents spies from stealing the PIN. The Office Action treats this PIN-entry as the claimed "authorization message."

Error 1

One of the two errors is that the cited passage in East merely states that, after the PIN is entered, the requested ATM transaction is "permitted" to continue. (Column 5, line 25.) That is, East's PIN-entry merely identifies the customer. After the customer successfully identifies himself, he can then continue with the transaction.

That does not show "**executing** the requested ATM transaction without obtaining any additional transaction authorization message" as in claim 44. At best, that shows **permitting** the **attempted** execution to proceed.

Common sense requires this conclusion. Is the PTO interpreting East as stating that his ATM dispenses cash without checking the customer's balance ?

Error 2

The second error is that, as explained above, East **explicitly states** that he shows an ordinary ATM.

09/848,003
Art Unit 3693
9227.00

An ordinary ATM contacts a central computer to check the customer's account balance, during the ATM transaction. That generates the "additional authorization message" which claim 44 states to be **absent**.

Conclusion as to Point 2

The cited passage of East merely states that the PIN-entry "permits" the ATM transaction to proceed. East's ATM will then obtain authorization, which is contrary to the claim.

Point 3

**Even if References are Combined,
Invention is not Attained
Part 3**

The Office Action, page 4, first paragraph, asserts that East shows

. . . examining the transaction authorization
message which has been received from the
portable device carried by the ATM customer
. . . .

In an abstract sense, this assertion may be true. East does examine some type of message received from the customer.

However, the message in East does not correspond to the claimed "message."

The "message" of claim 44(b) is defined thusly:

09/848,003
Art Unit 3693
9227.00

b) . . . a transaction authorization
message . . . which the ATM customer has
obtained

from an authorization center of a
financial institution

before making the requested ATM
transaction at the ATM.

That is, the claimed "message" has two attributes. One, it was obtained from "an authorization center of a financial institution." Two, it was obtained (from the authorization center) "before making the requested ATM transaction."

The supposed "message" in East lacks both these attributes. The PIN in East lacks both these attributes.

Point 4

Even if References are Combined, Invention is not Attained Part 4

Claim 44(c) recites examining the "authorization message" to determine whether it is valid. However, the claimed "authorization message" was obtained from an "authorization center." That does not correspond to the PIN of East's customer.

Nor does it correspond to other data which East's customer may enter, which is listed in column 4, lines 10 - 39. That data is not obtained from an "authorization center" either.

09/848,003
Art Unit 3693
9227.00

Interim Conclusions

The claimed "authorization message" is not found in East.
The claimed "authorization message"

- was obtained by the customer **before** the
ATM transaction,
- was obtained from an "authorization
center," and
- relates to the specific ATM transaction.

The PIN of East shows none of that.

Further, the claim states that no other authorization is obtained. That is directly contrary to East, who explicitly states that he shows an ordinary ATM. That ATM contacts a remote computer to check the customer's balances. That is additional authorization.

Point 5

East Reference is Being Modified, Which is not Allowed

As explained above, East obtains the additional authorization, which the claims state is absent. If this additional authorization is removed from East, then the basic operating principle of East is being modified. East cannot determine the balance of the customer, and thus cannot decide whether to dispense cash.

MPEP § 2143.01 prohibits this:

09/848,003
Art Unit 3693
9227.00

THE PROPOSED MODIFICATION CANNOT RENDER THE
PRIOR ART UNSATISFACTORY FOR ITS INTENDED
PURPOSE.

THE PROPOSED MODIFICATION CANNOT CHANGE THE
PRINCIPLE OF OPERATION OF A REFERENCE.

Point 6

Rejection is Erroneous: No ATM is Present in Yamamoto

The Office Action, page 4, last paragraph, and other locations, asserts that Yamamoto shows an ATM. That is not correct.

Yamamoto shows a portable computer which uses a wireless network. His Figure 10B may contain the phrase "MOBILE BANKING." However, that merely refers to so-called "home banking," in which a person can transfer funds using a PC.

That "MOBILE BANKING" does not involve an ATM.

The Office Action cites column 8, lines 12 - 23, in Yamamoto as showing the claimed authorization "message." However, that passage merely describes his Figure 10B, which Applicant described above.

The claimed "authorization message" is not found in Yamamoto.

THEREFORE, claim 44 states that

-- The user obtains an "authorization
message" from "an authorization center of a
financial institution."

-- This "authorization message" is obtained

09/848,003
Art Unit 3693
9227.00

"before making the requested ATM transaction
at the ATM."

-- No other authorizations are used in
executing the transaction.

The references, even if combined, fail to show that.

Point 7

The Office Action, page 4, last paragraph, admits that East fails to show an "authorization message" which was obtained (1) from an "authorization center" (2) prior to the transaction.

Yamamoto, column 8, lines 12 - 23, is cited to cure this deficiency.

However, as explained above, no "authorization message" as claimed is found at that location in Yamamoto. Thus, even if the references are combined, claim 44 is not attained.

Point 8

This is a continuation of Point 7.

The Office Action, page 4, last paragraph, asserts that Yamamoto shows

receiving from the portable device [carried]
by the **ATM customer** a transaction
authorization message which is associated with
the requested **ATM** and which the **ATM** customer
has obtained from an authorization center of
a financial institution [before the

09/848,003
Art Unit 3693
9227.00

transaction].

(Emphasis supplied.)

However, the undersigned attorney has examined Yamamoto, and cannot find any reference to an ATM, nor the "message," nor the "authorization center." Therefore, Applicant requests, under 37 CFR §§ 1.104(c)(2) and 35 U.S.C. § 132, that the PTO specifically identify these three elements in Yamamoto:

1. the claimed "authorization message,"
2. the claimed ATM, and
3. the claimed "authorization center."

Point 9

No Expectation of Success

In the present context, Yamamoto shows nothing more than a personal computer, PC, which connects to the Internet in a wireless manner.

It is utterly unclear how such a PC provides the claimed "authorization message," obtained from an "authorization center," before the ATM transaction, as the Office Action asserts in the passage cited in Point 8, above.

It is also unclear (1) how this "message" would be given to East's ATM and (2) what East's ATM would do with it.

Therefore, no expectation of success in combining the

09/848,003
Art Unit 3693
9227.00

references has been shown.

MPEP § 706.02(j) states:

Contents of a 35 U.S.C. 103 Rejection

. . .

To establish a prima facie case of obviousness, three basic criteria must be met.

. . .

Second, there must be a reasonable expectation of success.

. . .

The . . . reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure.

Point 10

No Valid Teaching Given for Combining the References

The rationale for combining the references is that the combination provides East with a mobile communication system which can use the Internet for banking services.

However, this rationale, as a matter of logic, does not lead to a combination of the references. If you want a mobile device to use the Internet for banking services, then simply follow Yamamoto's teachings **alone**. There is no need to add East.

Further, East is contrary to the concept of mobile banking. East shows a **stationary** ATM. It is not mobile.

Further still, no explanation has been given of how East

09/848,003
Art Unit 3693
9227.00

contributes to the mobile banking achieved over the Internet. What components of East assist in achieving this goal ?

Remaining Claims

The discussion above applies to the remaining claims.

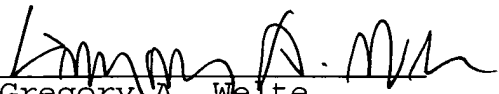
09/848,003
Art Unit 3693
9227.00

CONCLUSION

Applicant requests that the rejections to the claims be reconsidered and withdrawn.

Applicant expresses thanks to the Examiner for the careful consideration given to this case.

Respectfully submitted,


Gregory A. Weite
Reg. No. 30,434

NCR Corporation
1700 South Patterson Blvd.
WHQ - 3
Dayton, OH 45479
November 7, 2008
(937) 445 - 4956